



UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

PEARL COHEN ZEDEK, LLP
1500 BROADWAY 12TH FLOOR
NEW YORK, NY 10036

17 AUG 2006

In re Application of	:	DECISION ON
ADLER, Sam et al	:	
Int. Application: PCT/IL03/01117	:	
Application No.: 10/541,191	:	REQUEST UNDER
Int. Filing Date: 30 December 2003	:	
Priority Date: 30 December 2002	:	
Attorney's Docket No.: P-5608-US	:	
For: UNIVERSAL RETICLE TRANSFER SYSTEM	:	37 CFR 1.497(d)

This is a decision on petitioner's "PETITION TO ADD AN INVENTORS 37 CFR 1.324" filed on 14 June 2006, which is being treated as a request under 37 CFR 1.497(d) to add joint inventor Daniel Gat in the executed declaration. A petition fee of \$130.00 as been charged to petitioner's Deposit Account No. 50-3355 as authorized in the petition.

BACKGROUND

On 30 December 2003, applicants filed international application No. PCT/IL2003/01117 and claiming a priority date of 30 December 2002.

On 30 June 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee, but no executed declaration was submitted at such time.

On 22 February 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or declaration of the inventors, in compliance with 37 CFR 1.47(a) and (b), identifying the application by International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it: is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68. The notice also indicated that the items set forth above must be submitted within two (2) months from date of this Notice or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 18 April 2006, applicants filed, inter alia, an executed declaration but it did not include joint inventor Daniel Gat in the executed declaration.

On 14 June 2006, applicants filed, inter alia, a request under 37 CFR 1.497(d) to add joint inventor Daniel Gat in the executed declaration.

DISCUSSION

A submission under 37 CFR 1.497(d) must include:

- (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (2) the fee set forth in § 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have satisfied item (2) under 37 CFR 1.497(d), but not items (1) and (3).

With respect to item (1), the statement submitted on 14 June 2006 by Daniel Gat is sufficient because the statements state that the error in inventorship occurred without a deceptive intent in the national stage application. However, the executed declaration filed on 18 April 2006 is defective because it does not list alleged co-inventor Daniel Gat, which makes the statements moot as there is no support for his co-inventorship in the declaration.

With respect to item (2), the processing fee of \$130.00 has been charged to the Deposit Account No.: 50-3355.

With respect to item (3), Given Imaging, Ltd., the assignee, consents to the correction of inventorship to the above application and it has filed in the requisite papers establishing its right to take action under 37 CFR §3.73(b), since the assignment has been recorded in USPTO at Reel/Frame 017494/0862. However, this statement is moot because no executed declaration including alleged co-inventor Daniel Gat has been submitted.

Accordingly, the requests are deemed to satisfy requirements (1), (2), and (3) under 37 CFR 1.497(d).

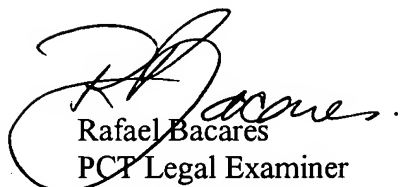
Accordingly, the request does not meet the requirements under 37 CFR 1.497(d).

CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'Rafael Bacares', is written over the printed name and title.

Rafael Bacares

PCT Legal Examiner

PCT Legal Office

Telephone: (571) 272-3276

Facsimile: (571) 273-0459